

### **REMARKS**

The final Office action dated August 16, 2005 and the references cited therein have been carefully considered. In response, Applicants offer the following remarks and respectfully requests reconsideration and withdrawal of the rejections identified below.

Claims 48-82 are pending and at issue in this application. Of these, claims 48, 58 and 66 are independent.

As an initial matter, the final Office action is ambiguous regarding the basis for the rejection of claims 48, 58, 66 and 74-82. For example, page 2 of the final Office action includes the subheading "Claim Rejections – 35 USC § 103" and recites the text of 35 U.S.C. § 103(a), but further states that "[c]laims 48, 58, 66 and 74-83 [are] rejected under 35 U.S.C. 102(b) as being anticipated by Claypole et al GB Patent application 2,262,642 in view of Gura et al US Patent 6,270,411. Claypole discloses all of the instant application, ...". In concluding the rejection on page 4 of the final Office action states "[i]t would have been obvious at the time of the invention ...". Until the Office Action provides a clear basis for rejection of the claims, Applicants assume that the basis for the rejection is 35 U.S.C. § 103 because the Office Action quotes 35 U.S.C. 103(a), cites a primary reference in view of a secondary reference and concludes that the claims "would have been obvious". Further the Office action does not provide any basis for an anticipation rejection, because the final Office action does not cite a single reference that discloses all the elements of the pending claims. Accordingly, if the Office action meant to reject the claims as anticipated, a new non-final Office action may be issued under the new grounds of anticipation.

#### **A. The Rejection Of Claims 48, 58, 66 and 74-82 Under 35 U.S.C. §103 As Obvious Over Claypole In View Of Gura et al. Is Not Proper.<sup>1</sup>**

It is respectfully submitted that a *prima facie* case of obviousness of claims 48, 58, 66 and 74-82 has not been made.

##### **1. A *Prima Facie* Case of Obviousness of Claim 48 Has Not Been Made.**

Claim 48 is directed to a gaming apparatus which includes, *inter alia*:

---

<sup>1</sup> The final Office action lists claims 48, 58, 66 and 74-83 in this rejection. However, there is no pending claim 83. Accordingly, Applicants assume the final Office action meant to refer to claims 48, 58, 66 and 74-82.

said controller being programmed to determine whether there are at least three related symbols displaying common subject matter in display regions that are contiguous and that relate to an aspect of a bonus game;

said controller being programmed to allow a player to operate a second input device to play an aspect of the bonus game in the display regions that display the at least three related symbols if said controller determines that there are at least three related symbols displaying common subject matter in display regions that are contiguous and that relate to the aspect of the bonus game;

As indicated above, claim 48 is directed to a gaming apparatus that includes a controller programmed to determine whether there are at least three related symbols displaying common subject matter in display regions that are contiguous and that relate to an aspect of a bonus game. If so, the controller is programmed to allow a player to operate a second input device to play an aspect of the bonus game in the display regions that display the at least three related symbols.

In the final Office action, claim 48 was rejected under 35 U.S.C. §103 as being obvious over U.K. Patent Application No. GB 2,262,642 to Claypole et al. (hereinafter "Claypole et al.") in view of U.S. Patent No. 6,270,411 to Gura et al. (hereinafter "Gura et al."). In support of the rejection, the final Office action alleged that "[with] respect to the claim limitation of 3 contiguous related symbols the applicant and the references teach that the outcome of the fruit machine, which is usually 3 symbols, advances the player to the bonus feature." In support, the final Office action alleged that "page 3 of Claypole et al. discloses that 'opportunity to play a feature on the screen may be achieved by means of a trail system or the like, dependent on the fruit machine game. Additionally or alternatively, opportunities to play the skill game may be presented in a random or quasi-random manner over the playing of a number of games of the fruit machine reel display.'" See final Office action dated 8/16/05, pages 2-3.

Further, the final Office action alleged that Applicants' specification "Background of the invention" paragraph 4 teaches three symbols lined up in order to get the bonus game. See final Office action, page 2.

Finally, the final Office action alleged that Gura et al. "teaches the use of three contiguous symbols to enter the bonus game (see 1:25-2:38, 16:41-59). Gura states that 'there is provided a gaming machine comprising a basic game controlled by a processor in response to a wager amount. The basic game has a first display screen and at least one start bonus outcome that activates a bonus game.'" See final Office action, pages 3-4.

- a. *Claypole et al. and Gura et al. fail to disclose at least three related symbols displaying common subject matter in display regions that are contiguous.*

Claim 48 recites, *inter alia*, a gaming apparatus wherein a controller allows a player to operate a second input device to play an aspect of a bonus game if there are at least three related symbols displaying common subject matter in display regions that are contiguous and that relate to the aspect of the bonus game. At issue is the triggering condition for the bonus game. The combined references simply fail to disclose each and every one of these elements. Accordingly, the obviousness rejection should be withdrawn.

The Office action bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability, and if examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the Applicant is entitled to grant of the patent.<sup>2</sup> To establish *prima facie* obviousness, all claim elements must be taught or suggested by the prior art.<sup>3</sup>

Claypole et al. discloses a trail system to trigger a bonus game. See Claypole et al., page 3, lines 17-20. Claypole et al. discloses that its trail system comprises trail value numbers associated with a minority of fruit game symbols. See Claypole et al., page 11, line 24 to page 12, line 4. Claypole et al. also discloses that the trail system triggers a bonus game only when a minimum threshold value is met or exceeded by adding the trail value numbers displayed along the win line for each play of the fruit machine. See Claypole et al., page 12, lines 5-12. However, the bonus game is triggered regardless of the relationship or subject matter of the symbols being displayed. In other words, the triggering event in Claypole et al. is based only on the added value of the trail numbers, and is not based on related symbols

---

<sup>2</sup> *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

<sup>3</sup> *In re Royka*, 490 F.2d 981 (C.C.P.A. 1974).

displaying common subject matter in contiguous display regions. Even if the trail value is occasionally associated with an arrangement of related symbols in contiguous display regions because of numbers attached to such an arrangement of symbols, such an occurrence is mere happenstance. The bonus game is still based only on the trail value determined by the numbers, and never based on the arrangement of related symbols displaying common subject matter in display regions that are contiguous.

Although the final Office action alleges that page 3, lines 17-23 of Claypole et al. discloses three contiguous related symbols, this is incorrect. As quoted in the final Office action, the “opportunity to play a feature on the screen may be achieved by means of a trail system or the like”. It is clear from the language of Claypole et al. quoted in the final Office action that the triggering event in Claypole et al. is the trail system, which is an added value of trail numbers as discussed above and not related symbols displaying common subject matter in display regions that are contiguous. Although the final Office action also mentions that “opportunities to play the skill game may be presented in a random or quasi-random manner over the playing of a number of games”, this cited portion of Claypole et al. merely suggests that the bonus opportunities may occur randomly or quasi-randomly. Accordingly, Claypole et al., including the portions of Claypole et al. cited in the final Office action, does not disclose or suggest a triggering event based on related symbols displaying common subject matter in contiguous display regions.

Applicants’ specification “Background of the invention” in paragraph 4 mentions a bonus feature themed around bowling. The bowling feature occurs when three bowling symbols line up on the game’s payline. The Office action surmises that this indicates to one skilled in the art that this feature is well known. However, Applicants’ mention of the game is not an admission of prior art, and the final Office action provides no basis to combine Applicants’ specification with either Claypole et al. or Gura et al. Instead, final Office action only bases the rejection of claim 48 solely on the combination of Claypole et al. in view of Gura et al. See final Office action, page 2 (“Claims 48, 58, 66 and 74-83 rejected under 35 U.S.C. 102(b) as being anticipated by *Claypole* et al GB Patent application 2,262,642 in view of *Gura* et al US Patent 6,270,411.”)(emphasis added).

Gura et al. discloses particular symbols to trigger the bonus game (“BOWLING ROLL”), such as a “bruiser”, a “lady” or a “wimpy guy”. As specified in column 10, line 56

to column 11, line 3 of Gura et al., the bonus game is triggered whenever the symbols appear anywhere on noncontiguous, alternating reels 130, 134, 138. The symbols do not appear on reels 132, 136, and therefore cannot appear in contiguous reels. *See also* Gura et al. Figs. 8, 9 and 10. In other words, the symbols displaying common subject matter do not appear on contiguous display regions (e.g., contiguous reels). For example, as seen best in Fig. 9 of Gura et al., the symbol of the “wimpy guy” appears only on noncontiguous, alternating reels 130, 134, 138. *See also* Gura et al. column 10, lines 56-59. Although Gura et al. discloses additional embodiments where the triggering symbols are in contiguous reels, the symbols are either of different subject matter and/or are not displayed in contiguous display regions. *See* Gura et al. column 9, line 34 to column 10, line 33; Fig. 8. Even in the undisclosed event that the same symbols (i.e., “bruiser”, “lady” or “wimpy guy”) are arranged in contiguous display regions, such an occurrence is mere happenstance. The bonus game is still ultimately triggered based on the occurrence of the symbols anywhere on the reels irrespective of position, and not based on symbols displaying common subject matter in contiguous display regions.

Although the final Office action alleges that column 1, line 25 to column 2, line 38 of Gura et al. discloses three contiguous symbols to enter a bonus game, this is incorrect. None of the cited portion of Gura et al. disclose or suggest three related symbols displaying common subject matter in contiguous display regions. For example, column 1, lines 25-42 of Gura et al. discloses a “secondary” or “bonus” game which may be played in conjunction with a “basic” game. The secondary or bonus game is entered upon the occurrence of a “selected event or outcome of the basic game.” However, the “selected event” or “outcome of the basic game” is not specified. Column 1, lines 46-58 of Gura et al. discloses a gaming machine with a presentation element capable of presenting a “start animation outcome” that activates an animation feature, but the “start animation outcome” is not specified. Column 1, line 59 to column 2, line 3 also discloses a gaming machine with a presentation element capable of presenting a “start animation outcome” that activates an animation feature, but again the “start animation outcome” is not specified. Column 2, lines 4-15 of Gura et al. discloses a method of operating a gaming machine which provides a basic game with a “start bonus outcome” and which provides a bonus game in response to the “start bonus outcome”. As with the “start animation outcome”, the “start bonus outcome” is not specified. Column 2, lines 16-28 of Gura et al. discloses a gaming machine with a basic game having a “start bonus

outcome” that activates a bonus game. Again, the “start bonus outcome” is not specified. Column 2, lines 29-38 of Gura et al. discloses a method of operating a gaming machine which provides a basic game having a “start animation outcome” and providing an animation in response to the “start animation outcome”. Yet again, the “start animation outcome” is not specified. Accordingly, column 1, line 25 to column 2, line 38 of Gura et al., as cited in the final Office action, disclose “start animation outcomes” and “start bonus outcome”, but does not disclose or suggest that such outcomes are three related symbols displaying common subject matter in display regions that are contiguous.

In response to Applicants’ previous arguments that Claypole et al. and Gura et al. do not render the claims obvious, the final Office action states the following on page 7:

“Applicant argues that the use of Gura teaches a bonus condition of non contiguous alternating reels as shown in figures 9 and 10 and the description relative to those figures. In the description Gura discloses that this is only one example. Column 16:41-59 disclose that ‘It will be appreciated that the present invention has generally been described with reference to a particular embodiment of the WHO DUNNIT?.TM. game, but the present invention is not limited to the particular embodiments described herein. For example, while the aforementioned game has a basic game in the form of a slot machine, the present invention may be implemented with virtually any type of game of chance or skill or combination of such games having outcomes (e.g., “start bonus” outcomes) which may trigger play of an animation feature or other bonus game. The basic game may comprise, for example, a video poker or video blackjack game. Other variations within the scope of the present invention include bonus games with different themes, different displays and/or different types of award presentations; basic games with different numbers and types of reels and/or symbol-s, different payoff modes and/or payline configurations; and basic or bonus games with different coin awards.’”

However, this cited portion of Gura et al. also does not disclose or suggest related symbols displaying common subject matter in display regions that are contiguous. The cited portion of Gura et al. only discloses that the gaming machine and method of Gura et al. is not limited to the specified embodiments. For example, the additional embodiments may include games of chance or skill “having outcomes (e.g., ‘start bonus’ outcomes) which may trigger pay of an animation feature or other bonus game”, but Gura et al. does not specify the “start bonus outcomes”. The additional embodiments may include different basic games, such as

video poker or video blackjack, neither of which provide disclosure regarding the trigger for a start bonus game. The cited portion of Gura et al. also discloses that the additional embodiments include "bonus games with different themes, different displays and/or different types of award presentations", but the mere recitation of different themes, displays or award presentations does not disclose the triggering event for such bonus games. Lastly, the additional embodiments may include "basic games with different numbers and types of reels and/or symbol-s, different payoff modes and/or payline configurations; and basic or bonus games with different coin awards". These examples generally mention different numbers, reel types, reel symbols, payoff modes, payline configurations and coin awards, but do not specify the triggering event for the bonus game. Accordingly, the portion of Gura et al. cited in the final Office action does not disclose or suggest that the additional embodiments include related symbols displaying common subject matter in display regions that are contiguous. Any interpretation that such additional embodiments include related symbols displaying common subject matter in display regions that are contiguous is mere speculation.

The rejection of claim 48 is therefore improper for failing to cite references that teach or suggest all of the claims limitations of independent claims 48, whether taken individually or in combination. It is clear that a *prima facie* case of obviousness cannot be established where all the limitations of a claimed combination are not taught or suggested by the prior art. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). See also MPEP 2143.03.

b. *The final Office action does not address all of the claim limitations.*

It is also submitted that the final Office action does not establish a *prima facie* case of obviousness, because the final Office action does not address all of the limitations recited in claim 48. To establish *prima facie* obviousness, all words in a claim must be considered.<sup>4</sup> However, the final Office action does not address the phrase "related symbols displaying common subject matter", much less allege this limitation as being disclosed or suggested in either Claypole et al. or Gura et al. Accordingly, the final Office action has not considered

<sup>4</sup> See Section 2143.03 of the M.P.E.P., which states: "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)."

the phrase “displaying common subject matter” as recited in claim 48. Further, for the reasons as set forth above, neither Claypole et al. nor Gura et al. disclose related symbols displaying common subject matter in contiguous display regions.

The rejection of claim 48 is therefore improper for failing to consider all of the claims limitations of independent claim 48. It is clear that a *prima facie* case of obviousness cannot be established where fewer than all words in a claim are considered in judging patentability of the claim. See *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). See also MPEP 2143.03.

c. *The references teach away from the combination Claypole et al. and Gura et al.*

It is further submitted that the final Office action does not establish a *prima facie* case of obviousness because the references teach away from the combination of Claypole et al. in view of Gura et al. In particular, Gura et al. teaches away from the triggering condition of Claypole et al. As discussed above, Claypole et al. discloses triggering a bonus game based on the combined value of numbers associated with select symbols rather than the occurrence of particular symbols. Gura et al., on the other hand, discloses triggering a bonus game based on the occurrence of particular symbols in non-contiguous display regions rather than their combined value. One of ordinary skill in the art would therefore not be motivated to use the occurrence of particular symbols as disclosed by Gura et al. and an event trail as disclosed by Claypole et al. in the same gaming apparatus because Gura et al. and Claypole et al. teach two different bonus game triggering conditions. Therefore, Claypole et al. and Gura et al. cannot be properly combined to disclose allowing a player to operate a second input device to play an aspect of a bonus game in a display region if there are at least three related symbols displaying common subject matter in display regions that are contiguous and that relate to the aspect of the bonus game, as recited in claim 48.

The rejection of claim 48 is therefore improper because the references teach away from each other, and cannot be combined. A *prima facie* case of obviousness cannot be established where the references teach away from their combination. See MPEP 2145(X)(D)(2).



**2. A Prima Facie Case of Obviousness of Claim 58 Has Not Been Made.**

Independent claim 58 is directed to a gaming method which includes, *inter alia*:

determining whether there are at least three related symbols displaying common subject matter in display regions that are contiguous and that relate to an aspect of a bonus game;

allowing a player to operate a second input device to play an aspect of the bonus game in the display regions that display the at least three related symbols if said controller determines that there are at least three related symbols displaying common subject matter in display regions that are contiguous and that relate to the aspect of the bonus game;

allowing the player to use manual dexterity on the second input device to effect the outcome of the bonus game if said controller determines that there are at least three related symbols displaying common subject matter in display regions that are contiguous;

It is respectfully submitted that claim 58 is not obvious for the same reasons as set forth above for claim 48.

**3. A Prima Facie Case of Obviousness of Claim 66 Has Not Been Made.**

Independent claim 66 is directed to a memory having a computer program capable of being used in connection with a gaming apparatus which includes, *inter alia*:

a fourth memory portion physically configured in accordance with computer program instructions that would cause the gaming apparatus to determine whether there are at least three related symbols displaying common subject matter in display regions that are contiguous and that relate to an aspect of a bonus game;

a fifth memory portion physically configured in accordance with computer program instructions that would cause the gaming apparatus to allow a player to operate a second input device to play an aspect of the bonus game in the display regions that display the at least three related symbols if there are at least three related symbols displaying common subject matter in display regions that are contiguous and that relate to the aspect of the bonus game;

a sixth memory portion physically configured in accordance with computer program instructions that would cause the gaming apparatus to allow a player to use manual dexterity on the second input device to effect the outcome of the bonus game if there are at least three related symbols displaying common subject matter in display regions that are contiguous;

It is respectfully submitted that claim 66 is not obvious for the same reasons as set forth above for claim 48.

**4. A *Prima Facie* Case of Obviousness of Claims 74-76 Has Not Been Made.**

Claims 74-76 depend from claim 48. It is respectfully submitted that claims 74-76 are not obvious for the same reasons as set forth above for claim 48.

**5. A *Prima Facie* Case of Obviousness of Claims 77-79 Has Not Been Made.**

Claims 77-79 depend from claim 58. It is respectfully submitted that claims 77-79 are not obvious for the same reasons as set forth above for claim 58.

**6. A *Prima Facie* Case of Obviousness of Claims 80-82 Has Not Been Made.**

Claims 80-82 depend from claim 66. It is respectfully submitted that claims 77-79 are not obvious for the same reasons as set forth above for claim 66.

**B. The Rejection Of Claims 54, 64 and 72 Under 35 U.S.C. §103 As Obvious Over Claypole et al. In View Of Gura et al. And Luciano, Jr. et al. Is Not Proper.**

The rejection of claims 54, 64 and 72 as being unpatentable over Claypole et al. in view of Gura et al. and further in view of U.S. Patent No. 6,050,895 to Luciano, Jr. et al. (hereinafter "Luciano, Jr. et al.") is not proper because the final Office action fails to establish a *prima facie* case of obviousness.

Claims 54, 64 and 72, which depend from claims 48, 58 and 66, respectively, were rejected under 35 U.S.C. §103 as being unpatentable over Claypole et al. in view of Gura et al. as applied to claims 48, 58 and 66, respectively, and further in view of Luciano, Jr. et al. To establish *prima facie* obviousness, all claim elements must be taught or suggested by the prior art. See *In re Royka*, 490 F.2d 981 (C.C.P.A. 1974).

Claims 54, 64 and 72, depend from claims 48, 58 and 66, respectively, and therefore include all the elements of claims 48, 58 and 66, respectively. As discussed above with respect to claims 48, 58 and 66, the final Office action failed to establish a *prima facie* case of obviousness. Accordingly, it is respectfully submitted that claims 54, 64 and 72 are not obvious.

**C. The Rejection Of Claims 56, 57, 59-63 and 67-71 Under 35 U.S.C. §103 As Obvious Over Claypole et al. In View Of Gura et al., Luciano, Jr. et al. And Adamczyk Is Not Proper.<sup>5</sup>**

The rejection of claims 56, 57, 59-63 and 67-71 as being unpatentable over Claypole et al. in view of Gura et al. and Luciano Jr. et al. and further in view of U.S. Patent No. 6,379,250 to Adamczyk (hereinafter "Adamczyk") is not proper because the final Office action fails to establish a *prima facie* case of obviousness.

---

<sup>5</sup> The final Office action lists claims 56, 57, 59-63 and 66-71 in this rejection. However, the rejection based on Claypole, Gura et al. and Luciano, Jr. et al. does not provide a basis for rejecting claim 66. Accordingly, Applicants assume the final Office action meant to refer to claims 56, 57, 59-63 and 67-71.

Claims 56 and 57 which depend from claim 48, claims 59-63 which depend from claim 58 and claims 67-71 which depend from claim 66, were rejected under 35 U.S.C. §103 as being unpatentable over Claypole et al. in view of Gura et al. as applied to claims 48, 58 and 66, respectively, and further in view of Luciano, Jr. et al. and Adamczyk. To establish *prima facie* obviousness, all claim elements must be taught or suggested by the prior art. See *In re Royka*, 490 F.2d 981 (C.C.P.A. 1974).

Claims 56 and 57 depend from claim 48, and therefore include all the elements of claim 48. Claims 59-63 depend from claim 58, and therefore include all the elements of claim 58. Claims 67-71 depend from claim 66, and therefore include all the elements of claim 66. As discussed above with respect to claims 48, 58 and 66, the final Office action failed to establish a *prima facie* case of obviousness. Accordingly, it is respectfully submitted that claims 56, 57, 59-63 and 67-71 are not obvious.

**D. The Rejection Of Claims 55, 65 and 73 Under 35 U.S.C. §103 As Obvious Over Claypole et al. In View Of Gura et al. And Dickinson et al. Is Not Proper.**

The rejection of claims 55, 65 and 73 as being unpatentable over Claypole et al. in view of Gura et al. and further in view of GB Patent Application 2,174,773 to Dickinson et al. (hereinafter "Dickinson et al.") is not proper because the final Office action fails to establish a *prima facie* case of obviousness.

Claims 55, 65 and 73, which depend from claims 48, 58 and 66, respectively, were rejected under 35 U.S.C. §103 as being unpatentable over Claypole et al. in view of Gura et al. as applied to claims 48, 58 and 66, respectively, and further in view of Dickinson et al. To establish *prima facie* obviousness, all claim elements must be taught or suggested by the prior art. See *In re Royka*, 490 F.2d 981 (C.C.P.A. 1974).

Claims 55, 65 and 73, depend from claims 48, 58 and 66, respectively, and therefore include all the elements of claims 48, 58 and 66, respectively. As discussed above with respect to claims 48, 58 and 66, the final Office action failed to establish a *prima facie* case of obviousness. Accordingly, it is respectfully submitted that claims 55, 65 and 73 are not obvious.

**E. The Rejection Of Claims 49-53 Is Not Proper.**

The Office Action Summary indicates that claims 48-82 are rejected. However, the final Office action does not provide any basis for rejecting claims 49-53. Further, claims 49-53, depend from claim 48, and therefore include all the elements of claim 48. As discussed above with respect to claim 48, the final Office action failed to establish a *prima facie* case of obviousness. Accordingly, it is respectfully submitted that claims 49-83 are not obvious and not anticipated.

**CONCLUSION**

Accordingly, Applicants respectfully submit that all pending claims are patentable over the art of record and should be allowed. In light of the foregoing, the prompt issuance of a notice of allowance is respectfully solicited.

Should the examiner have any questions, the examiner is respectfully invited to telephone the undersigned

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN LLP  
233 S. Wacker Drive  
6300 Sears Tower  
Chicago, Illinois 60606-6357  
(312) 474-6500

By: \_\_\_\_\_

Aaron M. Peters  
Registration No.: 48,801  
Attorney for Applicants

**October 17, 2005**